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AUG 20 2004

OFFICE OF PETITIONS

In re Application of	:	
Syed F.A. Hossainy, et al.	:	
Application No. 10/603,794	:	DECISION ON PETITION
Filed: June 25, 2003	:	UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 50623.221	:	

This is a decision on the petition under 37 CFR § 1.78(a)(3), filed May 3, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to the prior-filed nonprovisional applications set forth in the amendment filed concurrently with the instant petition.

The petition is **GRANTED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The instant pending application was filed on June 25, 2003, and was pending at the time of filing of the instant petition. A reference to the prior-filed nonprovisional applications has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the prior-filed nonprovisional applications is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the prior-filed nonprovisional applications was

submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. See 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

Petitioner has supplied patent numbers in his amendment for claim for priority to the prior-filed nonprovisional applications. Petitioner is reminded that a claim for benefit under 37 CFR 1.78 requires that a reference to the prior-filed application(s) should identify each such prior-filed application by the application number (consisting of the series code and serial number), along with indicating the relationship of the applications. Status of the nonprovisional patent applications (whether it is patented or abandoned) should also be included. If a parent application has become a patent, the expression, "Patent No. ____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "abandoned" should follow the filing date of the parent application. See MPEP 201.11. Additionally, it is noted in the amendment that the incorrect filing date appears for Application No. 09/447,652 (PN 6,287,638). Petitioner should ensure that each amendment submitted contains the correct information in order to avoid delays or errors in processing the amendment.

The granting of the petition to accept the delayed benefit claim to the prior-filed applications under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the prior-filed applications. In order for the instant application to be entitled to the benefit of the prior-filed applications, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the prior-filed applications should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the prior-filed applications noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the prior-filed nonprovisional application, accompanies this decision on petition.

Any questions concerning this decision on petition may be directed to Retta Williams at (703) 306-5594.

This application is being forwarded to Technology Center Art Unit 1762 for appropriate action on the amendment filed May 3, 2004, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the prior-filed nonprovisional applications.



Frances Hicks
Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

Attachment: Corrected Filing Receipt